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09/622,044	12/13/2000	Frederic Bordeaux	195910US0PCT	4048

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 12/12/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/622,044

Applicant(s)

BORDEAUX ET AL.

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/4/02, Amd. B, paper no. 11.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment dated 11/4/02. Claims 12-29 are pending.
2. The references cited in the International Search Report have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.
3. The amendment to the claims presents no new matter. Support can be found on p. 4, line 16.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19-20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 19-20 and 22, A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can

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render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 19 recites the broad recitation “wherein said plastic is a polyurethane” and the claim also recites “, which is a thermoplastic polyurethane” which is the narrower statement of the range/limitation. It is suggested to delete “plastic is a” and “, which” from the claim.

In the present instance, claim 20 recites the broad recitation “wherein said plastic is a polyethylene” and the claim also recites “, which is in the form of an ionomer resin” which is the narrower statement of the range/limitation. It is suggested to delete “plastic is a” and “, which” from the claim.

In the present instance, claim 22 recites the broad recitation “wherein said plastic is a thermoplastic polyester” and the claim also recites “, which is a poly(ethylene terephthalate)” which is the narrower statement of the range/limitation. It is suggested to delete “plastic is a” and “, which” from the claim.

#### ***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 12-18, 24, 26-27, and 28-29 stand rejected under 35 U.S.C. 102(b) as being anticipated by Mattimoe et al. (of record) as set forth in paragraph 5 of the previous office action.

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With respect to claims 12 and 28, Mattimoe, directed to making an anti-laceration automobile glazing that can be used as a windshield, sun roof, and **side window 12** (see Figure 1), teaches making the glazing according to “**any one**” of a variety of embodiments/phases set forth in the reference (column 3, lines 31-33), where one of the embodiments includes adhering glass sheets 15, 16 with an intercalary adhesive layer 17 having a thickness of more than 0.76 mm.

Please note that the reference teaches the adhesive having a thickness in the range 0.015-0.060 inches, which is equivalent to 0.38-1.52 mm, wherein the part of the range from 0.761-1.52 mm anticipates Applicants claimed invention (Figure 3; column 1, lines 34 and 48-51 and 57-58; column 3, lines 32 and 40-42 and 57-63).

Regarding claims 13-14, the reference teaches the glazing having anti-laceration properties in the non-intact state and the bent state (column 1, lines 45-60).

Regarding claim 15, the reference teaches the adhesive layer having a thickness less than or equal to 2 mm (column 3, lines 61-63).

Regarding claim 16, the reference teaches the adhesive layer having a thickness of less than or equal to 1.90 mm (column 3, lines 61-63).

Regarding claim 17, the reference teaches the adhesive layer having a thickness of less than or equal to 1.53 mm (column 3, lines 61-63).

Regarding claim 18, the reference teaches the adhesive layer being polyvinylbutyral (column 3, lines 44-46).

Regarding claim 24, the reference teaches the glass sheets having a thickness from 0.04-0.125 inches which is equivalent to 1.01-3.18 mm wherein the part of the range from 1.5-3 mm is consistent with Applicants claimed invention (column 3, lines 57-61).

Regarding claim 26, the reference teaches the glazing comprising a function at least one functional layer 18 (Figure 3; column 3, lines 63-66).

Regarding claim 27, the reference teaches the outer face of glass sheet 16 having the functional layer 18, which is plastic, thereon (Figure 3; column 3, lines 63-65).

Regarding claim 29, the reference teaches an automobile 13 comprising the anti-laceration glazing (Figure 1; column 3, lines 31-35).

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 13-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mattimoe et al., as set forth in paragraph 7 of the previous office action.

Regarding claim 13-14, if it is not taken that the reference teaches the glazing having anti-laceration properties in the non-intact and bent states, the skilled artisan would have appreciated that the reference teaches the glazing having an adhesive layer with a thickness greater than 0.76 mm, which according the present invention, results in a glazing having anti-laceration properties in the non-intact and bent states. Therefore, since the glazing of the reference and the glazing of the present invention both have an adhesive layer with a thickness greater than 0.76 mm only the expected results of the reference's glazing also having anti-laceration properties in the non-intact and bent states would have been achieved.

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10. Claims 19-23 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mattimoe et al. in view of the Admitted Prior Art in the specification of the present application as set forth in paragraph 8 of the previous office action.

Regarding claims 19-22, the reference is silent as to these particular adhesives. However, one reading the reference as a whole would have understood that the type of adhesive is not critical to the invention thereby making selection of the same within purview of one in the art, especially in light of the fact that the claimed adhesives are known in the art (page 2, lines 15-16 and 22-23 of present specification).

Regarding claims 23 and 25, the reference teaches the glass sheets having a thickness from 0.04-0.125 inches which is equivalent to 1.01-3.18 mm wherein the part of the range from 1.01-3.0 mm is consistent with Applicants claimed invention (column 3, lines 57-61). Selection of glass sheets having a core compressive strength from 1-50 MPa would have been within purview of one of ordinary skill in the art depending on the desired strength of the glass, especially in light of the fact that glass having a compressive strength within this range is known in the art (page 2, line 22).

#### ***Response to Arguments***

11. Applicant's arguments filed 11/4/02 have been fully considered but they are not persuasive.

12. On page 4 of the arguments, Applicants argue that Mattimoe discloses the automobile glazing being used for a side window but contains no further disclosure with regard to the side window, let alone the adhesive layer thickness.

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The examiner respectfully points out that Mattimoe teaches using the automobile glazing for a windshield, sunroof, and **side window** where the glazing is made according to “**any one**” of a variety of embodiments/phases set forth in the reference (column 3, lines 31-33). One reading the reference as a whole would have readily appreciated that this statement means that the glazing (be it the windshield, sunroof, or side window) can be made using any one of the embodiments disclosed in the reference, even if the reference only refers to the windshield, sunroof, or side window when reciting the method steps of a particular embodiment for making the glazing.

The examiner also points out that one of the embodiments teaches the adhesive having a thickness in the range 0.015-0.060 inches, which is equivalent to 0.38-1.52 mm, wherein the part of the range from 0.761-1.52 mm anticipates Applicants claimed invention (Figure 3; column 1, lines 34 and 48-51 and 57-58; column 3, lines 32 and 40-42 and 57-63). Based on the statement made in the Mattimoe reference at column 3, lines 31-33, the skilled artisan would have readily appreciated that this embodiment could be used to make the windshield, sunroof, and side window of Mattimoe.

13. On page 4 of the arguments, Applicants argue that Mattimoe teaches an adhesive thickness of 0.38-1.52 mm; therefore, the reference does not recognize any significance with regard to the presently claimed 0.76 mm minimum.

The examiner respectfully points out that the portion of applicants range from 0.761-1.52 mm clearly anticipates Applicants invention.



*Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
**Michael W. Ball**  
**Supervisory Patent Examiner**  
**Technology Center 1700**

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Jessica L. Rossi


Patent Examiner

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jl

December 6, 2002

  
Michael W. Ball  
Supervisory Patent Examiner  
Technology Center 1700